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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/202,681	12/23/1999	ERIC J. MATHUR	09010/044001	3238

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06/19/2002

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EXAMINER

HUTSON, RICHARD G

ART UNIT

PAPER NUMBER

1652

DATE MAILED: 06/19/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/202,681

Applicant(s)

MATHUR ET AL.

Examiner

Richard G Hutson

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 30 May 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 23 January 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-11.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_.

Continuation of 2. NOTE: Applicant's proposed amendment of the claims raises new issues that would require further search and/or examination. It is also pointed out to applicants that the previous amendments of 1/3/2002, Paper No. 19 and 3/14/2002, Paper No. 24 have not been entered, as indicated in the advisories of 1/16/2002, Paper No. 21, and 4/9/2002, Paper No. 25. It is therefore suggested that when making amendments after-final, applicants use the current pending claim (i.e. that which was rejected in the action of Paper No. 18, 8/14/2001) when making amendments, and base the version to show changes on the current pending claim (See especially "claim 1"). The proposed newly added limitations of Claim 1 raise new issues for consideration under 112 2<sup>nd</sup> paragraph clarity. The proposed newly added limitations of Claim 2, raise new issues for consideration under 112 2<sup>nd</sup> paragraph, clarity, such as applicants intent and support for "specifically identify". The proposed newly added limitations of Claim 5, raise new issues for consideration under 112 2<sup>nd</sup> paragraph, clarity, such as applicants intent in part a) as which "sequence" is obtained from *A. degenesii* and which "sequence" encodes a thermostable phosphatase. Further applicants newly proposed limitation of part c) would also require additional consideration with respect to 112 2<sup>nd</sup> paragraph as well as search. The proposed newly added limitations of Claim 10, raise new issues for consideration under 112 2<sup>nd</sup> paragraph, clarity, such as applicants new limitation that the claimed phosphatase has "activity as a thermostable phosphatase".

Continuation of 5. does NOT place the application in condition for allowance because the rejections of record remain based on the nonentry of applicants proposed amendment. Applicants continue to traverse the rejection of claims 1-11 under 35 USC 112, on the basis that the claimed polynucleotide fragments have both adequate structural and functional descriptions. A polynucleotide which comprises a mere 15 nucleotides of a 783 nucleotide sequence is not considered to be adequately described structurally for the reasons previously stated. Similarly those polynucleotide fragments which hybridize to a specific nucleotide sequence, may not necessarily identify those sequences and therefore are not adequately described functionally, for the reasons stated previously.



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